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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,793	12/08/1999	Christopher L. Knauf	MEDIDNA.049A	6923

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LAW OFFICES OF ERIK J. HEELS
2 CLOCK TOWER PLACE
SUITE 255
MAYNARD, MA 01754-2545

EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

86

Office Action Summary

Application No.

09/456,793

Applicant(s)

KNAUFT ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Election filed 10/27/2003 to the original application filed 12/08/1999.
2. Claims 1-27 are elected for examination. Claims 1, 12, 19 and 25 are independent claims.

Specification

3. The abstract of the disclosure is objected to because it exceeds the limit of 150 words. Correction is required. See MPEP § 608.01(b).
4. The disclosure is objected to because information regarding related applications cited at page 1 has not been updated. Correction is required.
5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code for example at pages 8 and 20. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international

application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

Claims 19-27 are rejected under 35 U.S.C. 102(e) as being anticipated by **Yamanaka et al.** (U.S. 5,983,247 – filed 05/1997).

As to independent claim 19, A method of generating index information for graphical or audio objects (*generates the index information; col.14, lines 55-56 & Fig. 14*), comprising:

- reading index information that is associated with a graphical or audio object (*the index information ...reads the tags in order from the start of the HTML document ...the tag is*

- ""; col.10, line 50-col.11, line 29*); and

- dynamically generating an electronic document based at least in part upon the contents of the index information (*the transmission data generating unit 112 ... the HTML document; col.10, line 54-col.12, line 38*).

As to dependent claim 20, Yamanaka teaches customizing, based at least in part upon the indexing characteristics of one or more information retrieval systems, the content of the electronic document (*col.11, lines 1-20*).

As to dependent claim 21, Yamanaka teaches the electronic document comprises a HyperText Markup Language file (*col.7, lines 40-53*).

As to dependent claim 22, Yamanaka teaches the audiovisual object comprises a bitmap image (*col.11, lines 22-29*).

As to dependent claim 23, Yamanaka teaches the graphical object is a multimedia presentation (a presentation of the content of the audio information; *col.12, lines 56-59 & Fig. 8B*).

As to dependent claim 24, Yamanaka teaches the graphical object is a streaming media file (image files; col.7, lines 40-53/ “V1” is a video elementary stream; col.20, lines 6-67).

As to independent claim 25, the rejection of independent claim 19 above is incorporated herein in full. However, claim 19 further recites “converting at least a portion of a graphical or audio object into index information.”

Yamanaka teaches converting at least a portion of a graphical or audio object into index information (*converting multimedia data; col.1, line 5- col.2, line 28/ generated index information; col.10, lines 14-55 & col.14, lines 42-62*).

Dependent claims 26-27 include the same limitations as in claims 20-21, and are similarly rejected under the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamanaka et al.** in view of **Schaefer et al.** (U.S. 5,826,268 – filed 12/1996).

As to independent claim 1, Yamanaka teaches a method of generating index information for audiovisual objects (*generates the index information; col.14, lines 55-56 & Fig. 14*), comprising: converting at least a portion of an audiovisual object into index information

(converting multimedia data; col.1, line 5- col.2, line 28/ generated index information; col.10, lines 14-55 & col.14, lines 42-62).

However, Yamanaka does not explicitly teach “obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced.”

Schaefer teaches obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced *(col.8, lines 43-51)*.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schaefer and Yamanaka because it would have provided the capability for protecting sensitive electronic document whenever necessary.

As to dependent claim 2, Yamanaka teaches dynamically generating an electronic document which comprises at least a portion of the index information *(col.9, line 66-col.10, line 5 & col.12, lines 41-59)*.

As to dependent claim 3, Yamanaka teaches customizing, based at least in part upon the indexing characteristics of one or more information retrieval systems, the content of the electronic document *(col.11, lines 1-20)*.

As to dependent claim 4, Yamanaka teaches the electronic document comprises a HyperText Markup Language file *(col.7, lines 40-53)*.

As to dependent claim 5, Yamanaka teaches the audiovisual object comprises a bitmap image *(col.11, lines 22-29)*.

As to dependent claim 6, Yamanaka teaches the audiovisual object comprises music *(col.7, lines 38-39/ col.11, lines 42-51/col.1, lines 51-55)*.

As to dependent claim 7, Yamanaka teaches converting at least a portion of the audiovisual object into index information text comprises identifying one or more words in the lyrics of the music (*Fig. 8B*).

As to dependent claim 8, Yamanaka teaches the audiovisual object comprises a multimedia presentation (*col. 12, lines 56-59 & Fig. 8B*).

As to dependent claim 9, Yamanaka teaches converting at least a portion of a graphical or audio object into index information comprises reading close captioned information that is associated with the audiovisual object (*Abstract*).

As to dependent claim 10, Yamanaka teaches the audiovisual object comprises a streaming media file (*col. 7, lines 39-63 / col. 20, lines 6-67*).

As to dependent claim 11 includes the same limitations as in claim 9, and is similarly rejected under the same rationale.

As to independent claim 12, the rejection of independent claim 1 above is incorporated herein in full. However, claim 12 further recites:

- reading index information that is associated with a graphical or audio object; and
- transmitting the obfuscated index information to an information retrieval system.

Yamanaka teaches:

- reading index information that is associated with a graphical or audio object (*the index information ...reads the tags in order from the start of the HTML document ...the tag is ""; col. 10, line 50-col. 11, line 29*); and
- transmitting the index information to an information retrieval system (*Figs. 11A-B & 12*).

Yamanaka does teach “transmitting the index information to an information retrieval system, but is silent on “transmitting the obfuscated index information to an information retrieval system.”

Schaefer teaches transmitting the obfuscated index information to an information retrieval system (*col.8, lines 43-51*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schaefer and Yamanaka because it would have provided the capability for protecting sensitive electronic document whenever necessary.

Dependent claims 13-16 include the same limitations as in claims 2-5, and are similarly rejected under the same rationale.

As to dependent claim 17, Yamanaka teaches the graphical object is a multimedia presentation (*col.12, lines 56-59 & Fig. 8B*).

As to dependent claim 18, Yamanaka teaches the graphical object is a streaming media file (*col.7, lines 40-53 & col.20, lines 6-67*).

Response to Arguments

8. Applicant's arguments filed 10/27/2003 have been fully considered but they are not persuasive. The restriction is proper because:

Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as generating index

information for audiovisual objects, invention II has separate utility such as converting from a language to another language and invention III has separate utility such as patterning recognition module. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group II is not required for Group III, restriction for examination purposes as indicated is proper.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lida	U.S Patent No. 6,119,135	issue dated: Feb. 25, 1986
Burrows	U.S Patent No. 5,765,158	issue dated: Jun. 9, 1998
Linoff et al.	U.S Patent No. 5,953,723	issue dated: Sep. 14, 1999
Sotomayor	U.S Patent No. 5,963,205	issue dated: Oct. 5, 1999
Palmer et al.	U.S Patent No. 6,002,798	issue dated: Dec. 14, 1999
Yahara	U.S Patent No. 6,532,313	issue dated: Mar. 11, 2003

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092.

The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Field can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231


Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.
OFFICIAL faxes must be signed and sent to (703) 872-9306.
NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen
January 5, 2004


SANJIV SHAH
PRIMARY EXAMINER